TRANSLATION OF AN OFFICE ACTION

of Japanese Patent Office

Re: Japanese Patent Application No.2002-534945

Patent Office Examiner: <u>Keiji Akagi</u>

Dated: Nov. 30, 2004

Mailed: Jan. 11, 2005

Attorney for Applicant: Tadahiko Itoh

Applied Provisions: Patent Law Sections 29, 36 and 37

The present application is deemed to be rejected based on items with the below mentioned grounds. If the applicant has any objection against this, an argument must be filed within 3 months from the mailing date of this action.

Reasons

<Reason 1>   Inventions described in the following claim(s) of the present application are not allowable since they does not satisfy the requirements of Japanese Patent Law 29(1) Main Paragraph.

In Claim 1, Claims 2-6, 16-22 (depending from Claim 1), Claim 11 and Claims 12, 33-36, 38-40, 47 (depending from Claim 11), information processing by software is concretely implemented using hardware resources. It is only a man-made rule.

Therefore, what is claimed in claims 1-6, 11-12, 16-22, 33-36, 38-40 and 47 cannot be deemed as a statutory "invention".

Since it is clear that what is claimed in claims 1-6, 11-12, 16-22, 33-36, 38-40 and 47 is not regarded as an invention defined in Japanese Patent Law 29(1) Main Paragraph, substantial examination for novelty and inventive step has not been carried out.

<Reason 2>   Since the present application does not possess unity of the invention, it does not satisfy the requirement of Japanese Patent Law 37.

1

Note

The relationship between claims 7 and 13 and the relationship between claims 7 and 14 do not satisfy any of the relationships listed in Japanese Patent Law 37(i)to(v).

Since the present application does not satisfy the requirements of Japanese Patent Law 37, substantial examination for novelty and inventive step has not been carried out for Claim 13, Claim 14, Claims 37, 41 (depending from Claim 13) and Claims 42-46,48 (depending from Claim 14).

<Reason 3>   Since the present application's claims are incomplete, as explained in the items 1 to 7 hereinafter, it has been judged that the present application does not satisfy the requirements contained in Para 6(ii), Art. 36 of the Japanese Patent Law.

Note

(1) In claim 7, constituent elements "content request device", "receiver", "insertion mechanism", "display preparation device" and "display device" are unclear since it cannot be understood how they are configured, how these elements are related to each other and how each element contribute to the system.

Therefore, the invention of claim 7 is unclear. Also, all claims that depend from claim 7 are unclear.

In claim 10, constituent elements "means for identifying", "means for...receiving", "means for inserting" and "means for displaying" are unclear since it cannot be understood how they are configured, how these elements are related to each other and how each element contribute to the system.

Therefore, the invention of claim 10 is unclear. Also, all claims that depend from claim 10 are unclear.

(2) "Decision unit" and "selection unit" of claim 8, "debit notice generator" of claim 9, "subscriber privacy mechanism" and "targeting mechanism" of claim 27 are unclear since it cannot be understood what kind of configuration they are and how these elements

are implemented. Also, relationships between these elements and the invention of claim 7 cannot be understood.

Therefore, claims 8, 9, 26 and 27 are unclear.

(3) In claim 15, "cause the computer system to perform the method recited in any one of claims 1-12" is unclear. As pointed out in <Reason 1>, what is claimed in Claims 1-6, 11-12 cannot be deemed as an invention. Therefore, it is unclear what kind of a medium would be a computer readable medium for causing the computer to perform such a thing that cannot be deemed as an invention.

Also, not all of the claims 1-2 are method claims. Therefore, "the method recited in any one of claims 1-12" is wrong and thus unclear.

Therefore, the invention of claim 15 is unclear.

(4) In claim 24, "The system according to Claim 1" is wrong and in Claims 28 and 29, "The method according to Claim 27" is wrong since these claims depend from the claims of different categories.

Therefore, the invention of Claims 24, 28-29 are unclear.

(5) In Claim 25, there is a phrase "a pre-registration device configured to...", however, there is no "pre-registration device" in Claim 7, and therefore, said "per-registration device" is unclear.

Therefore, the invention of Claim 25 is unclear.

(6) In Claim 30, a phrase "The system .... comprising a process for pre-registering ..." is unclear since it cannot be understood how a "system" comprises "a process".

Therefore, the invention of Claim 30 is unclear.

(7) "means for ensuring subscriber privacy" of claim 31 and "means for targeting said advertisement to a target audience" of claim 32 are unclear since it cannot be understood how they are configured and how these elements are implemented. Also, relationships between these elements and the invention of claim 10 cannot be understood.

Therefore, inventions of claims 31 and 32 are unclear.

Since the description in the claims for the inventions related to claims mentioned in items (1) to (7) is extremely unclear, no substantial examination regarding novelty and inventive step has been carried out.

If you have any questions in terms of this OFFICE ACTION, please contact the Examiner Shigeki Sakurai.

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Japanese Patent Application No.2002-534945

Your Ref.: 198568JP

Our Ref.: JOSM/P04903

1. Current set of claims includes two groups of method claims and four groups of system claims:

Method Group I (Claims 1-6, 16-22);

Method Group II (Claims 11, 12, 33-36, 38-40);

System Group I (Claims 7-9, 23-29);

System Group II (Claims 10, 30-32);

System Group III (Claims 13, 37, 41); and

System Group IV (Claims 14, 42-48).

2. As for Rejection Reason 1, we suggest amending the method claims so as to clarify that each step is performed by each hardware component of a computer. Please refer to the PROPOSED AMENDED CLAIMS attached herewith.

As for claim 17, please specify corresponding description in the specification.

As for claim 18, please specify corresponding description in the specification and let us know which data is pre-registered into which database.

As for claims 19 and 20, please specify corresponding description in the specification and how let us know how claims can be amended to clarify that hardware components are used.

3. In Rejection Reason 2, the Examiner states that the present application lacks unity of the invention (between claim 7 and 13, and between claim 7 and 14).

Claim 7 relates to a system for inserting an advertisement into a particular electronic content of an electronic book and claims 13 and 14 relates to a system for generating advertisement revenue using demographic information. Accordingly, it seems that an industrially applicable field and an object of the invention of claim 7 is different from those of claims 13 or 14, and therefore lacks unity of the invention (37(i)).

Accordingly, we suggest filing a divisional application containing System Groups III and IV (claims 13 and 14 and dependent claims). We believe that there is no lack of unity between claims 13 and 14. Alternatively, Groups III and IV may simply be cancelled if they are not of great importance.

Although Method Group II (claims 11, 12, 33-36, 38-40) have not been examined for rejection reasons other than Japanese Patent Law 29(1) Main Paragraph, Method Group II is directed to the same subject matters as System Groups III and IV. Therefore, if you wish to file a divisional application, Method Group II should also be included in the divisional application.

Please let us know how to proceed, i.e., filing a divisional application for System Groups III and IV or cancelling System Groups III and IV.

4. Rejection Reason 3 relates to unclear descriptions in the claims.

As for item 1, we suggest amending claims 7 and 10 as indicated in the PROPOSED AMENDED CLAIMS.

As for item 2, claim 8 and 9, we suggest amending the claims as indicated in the PROPOSED AMENDED CLAIMS.

As for item 2, claims 26 and 27, please specify corresponding description in the specification and how let us know how these claims can be amended.

As for item 3, current claim 15 does not cover all the method claims. In the PROPOSED AMENDMENT, claim 15 covers Method Group I. Also, we will move claim 15 a position after the last method claim. Also, we suggest adding a program claim covering method claims.

As for items 4 and 5, we will amend the claims on our side.

As for items 6 and 7, please specify corresponding description in the specification and how let us know how claim 30-32 can be amended.

5. We found that in Fig. 7, a processor 621 should be connected to a network 610 and also to a content table 662a and a targeting information table 622b. Please refer to the corrected Fig. 7 attached herewith.

6. Please give us instructions or any comments on the above, including a draft of amendments.